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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/707,655

11/07/2000

Alan R. Hirsch

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05/27/2005

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,655

Applicant(s)

HIRSCH, ALAN R.

Examiner

Christopher R. Tate

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24,25,27-33,35,36,38,41,42,45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 41 and 42 is/are allowed.
- 6) ☐ Claim(s) 24,25,27-31,35,36,45 and 46 is/are rejected.
- 7) ☐ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment filed March 24, 2005 is acknowledged and has been entered. Claims 24, 25, 27-33, 35, 36, 38, 41, 42, 45, and 46 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25, as amended, recites "An article of manufacture, comprising, packaged together: ... and b) at least one of the following, separately packaged elements: ..." followed by the three embodiments listed as (i) - (iii). This overall phrase including "separately packaged elements" with respect to the embodiments of (i) - (iii) is deemed new matter as no support was found for these limitations within the instant specification. Please note that although Applicants state in their November 1, 2004 response that support is found for these limitations on page 5 (lines 20-26), page 7 (lines 20-21), and in the paragraph bridging pages 5-6 of the instant specification, these passages are not deemed to provide adequate support for this overall claim phrasing therein.

Claim Rejections - 35 USC § 102

Claims 24, 27-30, 35, 36, 38, 45, and 46 stand rejected under 35 U.S.C. 102(b) as being anticipated by the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), or by McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract) for the reasons set forth in the previous Office action which are restated below.

Each of the cited references teach skin creams comprising cucumber and licorice extracts therein (see PROMT abstracts). The cited commercial cream products would inherently be contained within a vessel (such as a jar) having a cap, and would also inherently be within the claimed levels - e.g., the products would inherently provide a suprathreshold but not irritant amount of the odorant (i.e., based upon the definition provided on page 5, lines 8-19, of the instant specification, the natural cucumber and licorice extract odors within the cited commercial skin creams would inherently be within a level detectable by a normosmic individual but not at a level so high or intense that it would be perceived as noxious or painful - thus, also within the claimed decismel level, within a suprathreshold but not irritant concentration, and/or at a concentration up to a suprathreshold but not irritant concentration, as claimed). Further, please note that the functional effects instantly claimed would be inherent to the reference odorant-containing products, including their ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures including, e.g., licorice-based and cucumber odorants had the effect of

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increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification.

Again, with respect to the claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known composition (such as the commercial skin cream products disclosed by the cited references) does not lend patentable distinction to the composition, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir.1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight.

Therefore, each of the cited references is deemed to anticipate the instant claims above.

Claim Rejections - 35 USC § 103

Claims 24, 27-31, 35, 36, 38, 45, and 46 stand/are rejected under 35 U.S.C. 103(a) as being unpatentable over the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), and McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract) for the reasons set forth in the previous Office action which are restated below.

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The references are relied upon for the reasons discussed *supra*.

Based upon the beneficial teachings provided by the cited references with respect to the commercial skin care products disclosed therein, it would have been obvious to one of ordinary skill in the art to provide such articles of manufacturer within one or more conventional, easy-to-use containers/vessels (such as those claimed), and/or providing the odorant as an odorant composition within a cream, wherein the cream containing the odorant composition is at a level that reads upon a liquid.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant's arguments concerning the above art rejections have been carefully considered but are not deemed to be persuasive of error in the rejections. Applicant argues that neither of the moisturizing skin cream formulations of the above products describe anything about vaporous emissions of the described products, nor that such products would include a suprathreshold but not irritant amount of cucumber and licorice extract odors. However, without clear and convincing evidence to the contrary, the examiner maintains that the licorice and cucumber extracts (which one of skill in the art would reasonably discern as being incorporated therein so as to provided pleasant scents [odors] to such skin cream products) within the above skin cream products would inherently provide odorant concentrations within the levels instantly claimed.

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Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Drug & Cosmetic Industry publication entitled "Scentual responses" (Jan 1996, from PROMT database) for the reasons set forth in the previous Office action which are restated below.

The cited reference discloses that Dr. Alan Hirsch of the Smell and Taste Treatment and Research Foundation at the University of Chicago reported to the American Psychosomatic Society that various odorants including the combination of lavender and pumpkin pie caused increased penile blow flow (see last paragraph).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to provide an article of manufacturer comprising a blood-flow effective amount of an odorant, whereby the odorant is a mixture of lavender and pumpkin pie, based upon the beneficial teachings provided by Dr. Hirsh within the cited reference. The adjustment of particular conventional working conditions (e.g., further employing a device for administering such an odorant mixture for testing the olfactory ability of the subject - e.g. employing a separate container or other suitable device in order to efficiently place such an odorant mixture under the nose of a subject being tested/treated; and/or providing a result-effective amount of such a blood-flow odorant mixture as an article of manufacturer within a conventionally-employed, easy-to-use package/container - e.g., within a vial, a jar, a pouch, a can, a dispenser, a wicking material, a capped vessel having a tip, etc) is deemed merely a matter of design choice, judicious selection, and routine optimization which is well within the purview of the skilled artisan, based upon the beneficial teachings provided by Dr. Hirsch. Further, please note that the functional effects instantly claimed would be intrinsic to the odorants disclosed by Dr. Hirsch, including their ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant,

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women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification).

Again, with respect to the claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known composition (such as the commercial skin cream products disclosed by the cited references) does not lend patentable distinction to the composition, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight.

Thus, the invention of claim 25 is *prima facie* obvious over the reference, especially in the absence of evidence to the contrary.

Double Patenting

Claims 25 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-23 of U.S. Patent No. 5,885,614 for the reasons set forth in the previous Office action which are restated below.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to an article of manufacture comprising at least one odorant: undefined in instant claim 25; e.g., mixture of lavender and pumpkin pie odorants in the cited '614 claims; as well as being packaged within the same types of commercial containers/vessels. The US '614 packaged article of manufacture of claims 22-23 differs from the instantly claimed packaged article of manufacture in that it is drawn to a different intended use (including instructions for such use) than that instantly claimed (i.e., the instantly claimed article of manufacture is intended for altering blood flow to the vagina of a female, whereas the article of manufacture of claims 22-23 of US '614 is intended for increasing penile blood flow in a male). However, as discussed in previous Office actions, the intended use of the instantly claimed article of manufacture does not patentably distinguish the article of manufacture, *per se*. Please further note that the functional effects instantly claimed would be intrinsic to the odorants (e.g., a mixture of lavender and pumpkin pie odorants) within the claimed article of manufacture recited in claims 22-23 of US '614, including their ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification). The adjustment of particular conventional working conditions (e.g., providing a separate device for testing the olfactory ability of the subject - e.g. employing a separate container or other suitable device in order to efficiently place such an odorant mixture under the nose of a subject being tested/treated) is deemed merely a matter of

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judicious selection and routine optimization which is well within the purview of the skilled artisan. In addition (as discussed *supra*), with respect to the instantly claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known product does not lend patentable distinction to the product, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the instantly claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight with respect to the above obviousness-type double patenting rejection.

Applicant's arguments with respect to claim 25 in the art rejection and double-patenting rejection above have been carefully considered but are not deemed to be persuasive of error in the rejections. Applicant argues that amended claim 25 now includes a separately packaged element from among those recited in (i)-(iii) therein and, thus, is unobvious over the art (within the USC 103 rejection above) and over the cited claims in US '614 (within the double-patenting rejection above). However, as discussed *supra*, this type of modification - e.g. employing a separate container or other suitable device in order to efficiently place such an odorant mixture under the nose of a subject being tested/treated - is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

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Claim Objections/Allowable Claims

Claims 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 41 and 42 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Christopher R. Tate', is positioned above the printed name.

Christopher R. Tate
Primary Examiner
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